SUPREME COURT, U. S.

JUL 6 1967

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IN THE

Supreme Court of the United States

OCTOBER 1967

No. 222

JOHN M. SISKO,

Petitioner,

v.

SOUTHERN RESIN & FIBERGLASS CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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TABLE OF AUTHORITIES

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There are no special or important reasons why the writ prayed for should be granted.

The decisions of the Court of Appeals for the Fifth Circuit and of the District Court both held the patent in suit invalid for the same reason. There is no conflict between decisions of Courts of Appeals or between the decisions of the two Courts below. No question of public importance is presented. Petitioner does not even present a question of law, but merely factual arguments based on alleged facts that are contrary to the findings of the District Court.

Opinions Below

The opinion of the Court of Appeals for the Fifth Circuit is reported at 373 F. 2d 866.

The findings and conclusions of the District Court are reported at 248 F. Supp. 797.

The District Court held the patent invalid on several grounds and also no infringement because of a file wrapper estoppel. The Court of Appeals affirmed on invalidity and said it was unnecessary to pass on the other issues.

These opinions appear in Petitioner's Appendix at App.* 3-11 and 13-28, respectively.

Jurisdiction

Jurisdictional requisites are set forth in the Petition.

Question Presented

Petitioner's "Question Presented" raises no issue for review by this Court. Instead, Petitioner merely argues that the holding of obviousness based on factual inquiries, as to which both Courts below are in agreement, "must be in error".

Petitioner's fact allegations (a) to (h) (p. 3) on which the "Question Presented" is based are argumentative and, in large part, contrary to the evidence and findings of the District Court. For example, the patented structure was not "a radical departure from the prior art", but amounted only to differences in structural details in an otherwise old combination (Findings 14, 15, 19 and 20; App. 22, 24). Petitioner's references to industry acceptance as shown by Respondent's "own survey," to the manufacturing of a "direct copy of the invention," to the "infringing product" that enjoyed commercial success, and the "advertising and promotion of the infringing product" by the "infringer" are wholly erroneous and directly contrary to the findings of the Courts below. These fact arguments of Petitioner are based on the erroneous assumption that the accused products were a copy of the patented article and an infringe-

* The pages of the Appendix to the Petition will be referred to hereafter as "App." followed by the page numbers.

ment of the patent. The District Court's Findings 5, 7 and 8 (App. 16-19) are just the opposite and are fully supported by the evidence.

Statement of the Case

Sisko, the Petitioner and patentee, did not originate the system of using balsa wood blocks as a reinforcing core material in plastic boat construction. As a balsa wood salesman in 1959 and 1960, he became familiar with the balsa wood blocks laid out in the form of sheets held together by an open mesh cotton scrim cloth glued to one surface of the blocks for use as cores in the manufacture of plastic boats (R 228-34, 281-2, 352). This system was part of the prior art and used in 1959 and 1960 by the Edwards Boat Company and Nortex Manufacturing Company (R 145-7, 156-7, 163-77, 229-34, DXs 4, 21 and 27). Petitioner's expert witness was also aware of this prior art practice (R 270-80).

The patent in suit (filed May 24, 1963) claims the same basic combination, balsa wood blocks held together in sheet form by a flexible, stretchable backing for use as a core material in making plastic boats. The differences claimed in the patent over this prior art are differences only in details, *viz.*, the use of smaller blocks, a nylon mesh cloth instead of a cotton scrim cloth and the use of spot gluing (Finding 19, App. 24; Ct. of Appeals Op., App. 10).

Petitioner used smaller blocks, the stretchable nylon mesh backing and the spot gluing features so that the assembly would conform more readily to curvatures used in the more modern hulls of plastic boats. The District Court found that as the shape of boat hulls changed over the years, any skilled mechanic could have found ways of binding the balsa wood blocks together to make them more flexible (Finding 20, App. 24).

The prior art also included two prior patents which had not been cited by the Patent Office during the prosecution

of the patent in suit, Ams patent 476,354 (DX 28) and Cunninghame patent 972,754 (DX 29).

Anything that was lacking in the flexibility or drapeability of the assemblies in the prior use of balsa blocks for making plastic boat hulls was clearly taught by the Ams and Cunninghame patents, also a part of the prior art. This is precisely what the District Court found (Findings 16-24, App. 22-26) and the Court of Appeals agreed (App. 8-11).

At most, the patent in suit claims an old combination with minor structural changes. Petitioner relies heavily upon commercial success which may very well have been as attributable to his past training as a salesman of balsa wood products as to any unusual merit of the patented product. In any event, as this Court said in *A & P Tea Co.* v. *Supermarket Corp.*, 340 U. S. 147, 153 (1950):

> "But commercial success without invention will not make patentability."

Petitioner argues a long-felt want in the industry for the patented product and quotes some charitable language from the Court of Appeals decision in this respect. There is no evidence that either the Edwards or Nortex Company in 1959 and 1960 was not completely satisfied with the balsa wood core materials they were then using in plastic boats. Petitioner, the patentee, testified that in 1961 and 1962 he could not have gotten the boat builders to test his products if he had given them away (R 310-11). This is hardly indicative of a long-felt need in the industry.

Thus, even Petitioner's fact arguments for a holding of nonobviousness do not stand up under a careful scrutiny of the record.

While the Court of Appeals did not find it necessary to pass on this issue, the District Court found as a fact that Petitioner, the patentee, had made repeated commercial sales of his patented product to Bertram Yacht Company in Miami more than one year before his filing date (Find-

ings 10-13, App. 19-21). Accordingly, the District Court held the patent in suit invalid on this additional ground (App. 27).

Reasons for Denying the Writ

Petitioner appears to assert (Petition, pp. 12-13)

(a) that this Court did not lay down sufficient guidelines for determining the issue of obviousness in *Graham* v. *John Deere Co.*, 383 U. S. 1 and *United States* v. *Adams*, 383 U. S. 39 (1966), and

(b) that the Courts below did not properly follow these decisions in deciding the patent here in suit to be invalid for obviousness.

As to the first point, this Court clearly recognized in *Graham* (pp. 17-19) that while the ultimate question of validity is a question of law, the determination of obviousness lends itself to several basic factual inquiries which this Court proceeded to point out and discuss.

Because of its very nature, the question of obviousness is essentially a determination or conclusion arrived at on the basis of a number of separate factual inquiries. Petitioner does not suggest, and we cannot imagine, how this Court could have laid down more explicit guidelines for this determination. Each case necessarily has to be decided on its own facts.

All the Petitioner has asserted is an argument of the facts of this case. There can be no doubt that the District Court applied the right standards and guidelines, even though the District Court's findings were made before the *Graham* and *Adams* decisions (see Findings 19-24, App. 24-6). The Court of Appeals decision likewise properly applied the test of *Graham* to the facts of this case (App. 7-11).

CONCLUSION

The Petition should be denied.

Respectfully submitted,

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